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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,149	07/10/2003	Marc M. Jalisi	ACS 64748 (1331P2D2)	4067
22852	7590	02/14/2006	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			HO, UYEN T	
		ART UNIT	PAPER NUMBER	
		3731		

DATE MAILED: 02/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/618,149	JALISI, MARC M.	
	<b>Examiner</b>	<b>Art Unit</b>	
	(Jackie) Tan-Uyen T. Ho	3731	

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 28 November 2005.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 39-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 39-58 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 39-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lau et al. (5,514,154) in view of Armini (5,919,126). Lau et al. disclose a stent being made from metal, superelastic NiTi alloys and the stent pattern formed from a tube. Although, Lau et al. do not disclose the stent tube including a first layer of a first metallic material and a second layer of metallic radiopaque, attention is directed to Armini reference which discloses a stent being made from metal wherein the stent include a first layer of a first metallic material bonded to the exterior surface of the stent substrate to facilitate adhesion of a second layer of metallic radiopaque and wherein the layers having thickness and materials as claimed. It would have been obvious to one having ordinary skill in the art at the time the invention was made in view of Armini to employ the layers as claimed into Lau et al.'s stent tube in order to provide a stent with improved X-ray visibility.

Regarding claims 45-47, although the teach of Lau et al. in view of Armini does not disclose the materials as claimed, it would have been obvious matter of design choice to modify the device of Lau et al. in view of Armini to have the materials as claimed, since applicants has not disclose that having such specific materials as

claimed solve any stated problem or for any particular purpose and it appears that the stent would perform equally well with material as disclosed by Lau et al. in view of Armini or materials as claimed or other materials known in the art.

A limitation of the claimed combination which presented no novel or unexpected result over a similar feature used in the prior art references, and solved no stated problem, was held to be an obvious matter of design choice within the skill of the art. *In re Kuhle*, 526 F2d 523; 188 USPQ 7 (CCPA 1975). *In re Gazda*, 42 CCPA 770; 219 F2d 449; 104 USPQ 400 (1955). *In re Launder*, 42 CCPA 886; 222 F2d 371; 10 USPQ 446 (1955).

Regarding claims 56-58, the patentability of a product does not depend on its method of production. *In re Pilkington*, 411 F.2d 1345, 1348, 162 USPQ 145, 147 (CCPA 1969). If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Marosi*, 710 F.2d 799, 803, 218 USPQ 289, 292-93 (Fed. Cir. 1983); *Johnson & Johnson v. W.L. Gore*, 436 F.Supp. 704, 726, 195 USPQ 487, 506 (D. Del. 1977); see also *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). In this case the product of the Lau et al. in view of Armini is a stent having three layers, a superelastic alloy substrate tube, a first metallic layer and a second metallic radiopaque layer and the stent pattern including a plurality of cylindrical elements and interconnecting elements.

Regarding the length as claimed, it is well known in the art that a stent has the length as claimed to accommodate and support the vessel including a treated area

within that that range. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the Lau et al. in view of Armini' stent having the length as claimed in order to support a treated area with that range.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to (Jackie) Tan-Uyen T. Ho whose telephone number is 571-272-4696. The examiner can normally be reached on MULTIFLEX Mon. to Sat..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ANHTUAN NGUYEN can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



(Jackie) Tan-Uyen T. Ho  
Primary Examiner  
Art Unit 3731

February 8, 2006